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IN THE
Supreme Court of the United States

OCTOBER TERM, 1943.

No. 853

PAUL J. BELLAVANCE,
Petitioner,
v.
FRANK MORROW CO., INC.,
Respondent.

**PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE FIRST CIRCUIT, AND BRIEF
IN SUPPORT THEREOF.**

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TO THE HONORABLE THE CHIEF JUSTICE OF THE UNITED
STATES, AND THE ASSOCIATE JUSTICES OF THE SUPREME
COURT OF THE UNITED STATES:

Your petitioner, Paul J. Bellavance, respectfully prays for a writ of certiorari to the Circuit Court of Appeals for the First Circuit to review the judgment of that court entered February 4, 1944, a petition for rehearing filed thereafter being denied February 24, 1944 and a motion to reconsider the denial of plaintiff's petition for rehearing filed March 3, 1944 being denied with a second opinion March 17, 1944. In the latter opinion the First Circuit Court pointed out the "confusion in the law with respect to the nature of the question of patentable invention" (last page of Opinion) and stated that the United States Supreme Court has by recent cases established two different standards of invention the application of which one depends upon how the case got there, and that the First Circuit will adhere to the strict standard until the confusion in the law is cleared up (p. 3 of Opinion).

Summary and Short Statement.

The issues here are has the United States Supreme Court set up two standards of invention, as the First Circuit Court of Appeals states it has, and if so which standard of invention is applicable to this, and similar patent cases, namely, the strict one set up in *Cuno v. Automatic*, 314 U. S. 84, 91, or the more liberal one towards patents recently set up in *Goodyear v. Ray-O-Vac* (decided February 28, 1944, 60 USPQ 386). Other issues are whether or not the basic law of patents that the burden of proving a patent invalid rests upon the patent's assailant was abrogated by *Cuno v. Automatic*, 314 U. S. 84, and whether or not a federal court may justifiably rely solely upon its own belief of what the prior art and prior knowledge was, unsupported by evidence and upon its belief alone declare a patent invalid, and whether or not a patentee now has the burden of proving his patent valid, and whether or not a district court may ignore the rules of civil procedure and refuse to decide issues before it.

Plaintiff filed suit in the District Court of the United States (Rhode Island) on the Bellavance patent in suit No. 2,108,247 for a Bracelet and Method of Making the same (p. 117) and the Manickas patent No. 2,114,930 for a Bracelet (p. 123). The latter patent covered an improvement in the said bracelet invented and patented by Bellavance. Defendant was charged with infringement of all the claims.

The District Court entered judgment for the defendant, although it made no findings whatsoever on the method claims, which were in issue. The First Circuit Court of Appeals affirmed the District Court, holding all of the claims of the two patents in suit invalid. A Petition for Rehearing was filed February 16, 1944 and denied February 24, 1944, and a motion to reconsider was filed March 3, 1944 and denied with an opinion March 17, 1944.

Two bracelets Exhibits 2 and 5 (Rec. p. 42) were alleged to be an infringement of the article claims of both patents in suit, and the methods used to make the two bracelets were alleged to be an infringement of the three method claims in suit. The District Court judge, other than to include a copy of method claim 2, in its opinion, did not discuss or make any finding whatsoever concerning validity of the method claims. No prior art patents, prior uses or any prior knowledge whatsoever was cited or argued against the method claims. If there exists any prior knowledge in any art of the method that includes an entirely new step of claims 2, 3 and 4 of the Bellavance patent (p. 120) it is not in this record, which includes the file wrapper of said patent, Exhibit O. The vital inventive step Bellavance took was from infinity (no prior art whatsoever) to a new and successful method that produces a new and successful bracelet construction.

The First Circuit Court of Appeals has uprooted a basic law of patents that the burden of proving a patent invalid rests upon the assailant, which law was reiterated in 1937 by Justice Stone in *Smith v. Hall*, 301 U.S. 216, 57 S. Ct. Rep. 711.

When the decision in *Goodyear v. Ray-O-Vac*, (60 USPQ 386) was handed down February 28, 1944 it was called to the attention of the First Circuit Court by a Motion to Reconsider, with the result that its second opinion held that the strict standard of invention set forth in *Cuno v. Automatic*, 314 U.S. 84, 91 was applicable to this case (Second Opinion p. 3) rather than the more liberal standard set up in the later *Goodyear* case, because it was more likely to result in a uniform application of patent law amongst the lower courts (Second Opinion p. 3). If the standard in the *Goodyear* case prevails then the patents in suit are valid, or, at least the method claims are, because all the requirements of a valid patent as set up in the *Goodyear* case are present in the nature of findings of fact with respect to said patents.

Jurisdiction.

This Court has jurisdiction to review the judgment in question under 240-A of the Judicial Code (28 U. S. Code, Sec. 347), and because the First Circuit Court of Appeals has decided a federal question of patent law not in accord with applicable decisions of this court. And because the said First Circuit Court has decided a question of basic law in a patent case in conflict with a decision of the Circuit Court of Appeals for the Second Circuit. See Supreme Court rule 38, (5) (b).

Questions Presented.

The questions presented are whether or not the First Circuit Court is correct in holding that the standard of invention set up in the *Goodyear* case decided February 28, 1944 which is comparatively liberal towards patents is not applicable to this case, and whether or not the standard of invention set up in the *Cuno v. Automatic* case is stricter than in the *Goodyear* case, and if so must and do the claims in suit measure up to it. U. S. Supreme Court rule 38, paragraph 5 (a) and (b).

A further question is whether or not the ultimate question of validity of a patent is a finding of fact or a conclusion of law. If only a finding of fact all courts above the district court are bound by the latter's decision unless clear error appeared, whereas if it is an inference or conclusion drawn from the facts or an ultimate conclusion of law then the appellate courts are free to draw their own inferences or conclusions of fact or law from the subsidiary findings of fact made by the district court. U. S. Supreme Court rule 38, paragraphs 5 (a) and (b).

A further question presented is whether or not the burden of proving a patent invalid has been lifted from the patent's assailant. U. S. Supreme Court rule 38, paragraph 5 (b).

Another question is presented is whether or not a court can rely solely upon its *belief* of what a journeyman in the art would, know thereby providing out of its own imagination an irrelevant argument—not evidence or judicial knowledge—of a patent's invalidity, and if the burden of proving a patent valid is now on the patentee, and if a district court may ignore the Rules of Civil Procedure and refuse to decide issues presented before it and refuse to make findings called for by said rules. U. S. Supreme Court rule 38, paragraph 5 (b).

Reasons Relied Upon for the Allowance of the Writ.

Petitioner believes that this writ of certiorari should be granted in this case for the following reasons and accordingly the discretionary power of this Court is invoked:

That the First Circuit Court is in error in its application of the law as explained in its second opinion of March 17, 1944 that the United States Supreme Court has set up two standards of invention, one strict and one liberal, and that which one is applied to a patent depends upon how the case gets to the Supreme Court, namely, either to resolve a conflict between decisions of two Circuit Courts of Appeals, or to review a decision by only one Circuit Court of Appeals; but if that is correct the Supreme Court should explain and settle upon the application of said standards.

That the First Circuit Court is in error in applying the allegedly strict standard of invention to the patents in suit set forth in *Cuno v. Automatic*, and in declaring the patent claims in issue invalid even on the strict standard.

That the First Circuit Court is in error in not choosing the later and more liberal standard of invention set forth in the *Goodyear* case decided February 28, 1944 and applying that to the patents in suit.

The decisions of the Circuit Courts of Appeals for the First Circuit and Second Circuit are directly in conflict on the question of whether or not a patent can be declared invalid without any evidence of its invalidity or definite judicial knowledge or cognizance of prior knowledge of a method related to the invention. In other words, can a Court examine an invention and declare it invalid merely on its own belief—not upon evidence or judicial cognizance of a fact.

The Second Circuit Court of Appeals held on January 25, 1943 after the case of *Cuno v. Automatic*, *supra*, had been decided by the U. S. Supreme Court, that unless there was some evidence in the record of invalidity that a patent cannot be declared invalid. In that case the patent in suit had previously been held invalid upon established evidence of prior art articles. The patent owner started another suit in the same circuit against another infringer. A motion to dismiss was filed with an argument that the patent was invalid, although there was no evidence of prior art to support the argument. The district court judge granted the motion on the ground that the validity of the patent had been decided adversely in another case in the same circuit. The Circuit Court reversed this decision, because there was no *evidence* of invalidity offered in the case then before it. This was the case of *Gold Seal v. Westerman*, cited January 25, 1943, 56 USPQ 281, 133 F. (2d) 192. The 2nd Circuit judges Swan, Augustus N. Hand and Frank, relied upon the cases of *Smith v. Hall*, 301 U. S. 216, 218, *Lektophone Corp. v. Miller Bros.*, 37 F. (2d) 580, 581 and *Minerals Separation v. Butte & Superior Copper Co.*, 237 F. 401, 402.

In the instant case the First Circuit Court of Appeals stated:

"that the Bellavance method is ingenious and a step forward in the art of making bracelets," (p. 220).

It also stated:

"To be sure Bellavance appears to have been the first one to use the method disclosed in his patent in the art of making bracelets, but in the absence of evidence that the art was waiting impatiently for his contribution we cannot say that invention is unmistakably indicated thereby. It can be said that the Bellavance method is ingenious and a step forward in the art of making bracelets, but in view of the high standard of invention indicated by recent opinions of the Supreme Court (See *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84, 91, 92), we cannot believe that it is a sufficiently substantial step to warrant the grant of a patent. *Atlantic Works v. Brady*, 107 U. S. 192, 200" (pp. 219, 220).

The Court held that these method claims were invalid because:

"We believe that this is the kind of thing which workmen are accustomed to do almost as a matter of routine and we cannot believe that any uncommon skill was involved in conceiving a vise-like 'jig' such as is disclosed in the Bellavance patent" (p. 219).

The Court offers no clue as to where or how it got its belief that workmen are accustomed to do this almost as a matter of routine. The record shows that those in the bracelet manufacturing business, including defendant's expert, all used the old soldering method to hold the hinge plates to the bracelet sections, and that after learning of Bellavance's method they immediately adopted it.

The *Cuno v. Automatic* case, *supra*, has been a most puzzling one to the Federal Courts and the patent bar. Some courts, such as the First Circuit Court of Appeals, understand that it wiped away the presumption that a patent is valid and "fair upon its face" as Justice Cardozo said in *Radio v. Radio*, 293 U. S. 1, and that a court can declare a patent invalid on nothing more than its belief that it is invalid. Said courts understand that the burden of proof is no longer upon the alleged infringer and that Justice Cardozo's statement that a patent "is presumed to be valid until the presumption has been overcome by convincing evidence of error." in *Radio v. Radio*, *supra*, is not the law now. The First Circuit Court of Appeals has now placed the burden of proving the patent valid upon the patentee. In the instant case, it said:

"To be sure Bellavance appears to have been the first one to use the method disclosed in his patent in the art of making bracelets, *but in the absence of evidence that the art was waiting impatiently for his contribution* we cannot say that invention is unmistakably indicated thereby" (pp. 219, 220).

From now on in the First Circuit the patentee must "unmistakably" indicate invention. The burden is upon him to prove validity, and his patent is *prima facie* invalid it appears, all on account of the case of *Cuno v. Automatic*, *supra*. (The flash of genius test in this latter case was specifically rejected in *Chicago Steel Foundry Co. v. Burnside Steel Foundry Co.*, (C. C. A. 7, 1943) 132 Fed. (2d) 812, 817.

Whether or not the *Cuno v. Automatic*, *supra*, case was intended to make great and fundamental changes in basic patent law is a question that courts and authors have attempted to answer in various ways. The Journal of

the Patent Office Society has had a run of special articles written by authors and patent attorneys in the past 14 months interpreting that decision in conflicting ways. Nowhere did the U. S. Supreme Court say clearly and definitely that the burden of proving a patent invalid is no longer on the patent's assailant. Nor did it say that a court could rely solely upon its belief of what the prior art was to invalidate a patent as not constituting a patentable step forward. In that *Cuno v. Automatic* case there were many prior art patents discussed that were relevant and close to the patented article.

The District Court (Rhode Island) had all of the claims of the patent in this suit before it for decision; yet in defiance of the Rules of Civil Procedure it made no findings whatsoever concerning the method claims and did not say a word to indicate these claims were in issue, except to include a copy of claim 2 in its opinion. When the omission was called to its attention by appropriate motions (Rec. p. 20) it immediately denied them at the close of the oral argument on the motions. Upon the occasion of these motions plaintiff filed three requests for rulings of law (Rec. p. 25) in which he posed the very questions of law now before this court, the first two of which are especially pertinent here: namely:

"1. The burden of proof is on the defendant in a patent infringement suit to show that the patent is invalid. See Walker on Patents under burden of proof and *Radio v. Radio*, 293 U. S. 1."

"2. Since the defendant offered no prior art or other evidence to show that the Bellavance method claims 2, 3 and 4 in suit were invalid, as a matter of law these claims are valid. See *Gold Seal v. Westerman*, 56 U. S. P. Q. Advance sheets page 281, decided January 25, 1943, by the C. C. A. (2nd)" (p. 25).

These requests for rulings of law were denied on April 5, 1943 (Rec. p. 35), and were appealed (pp. 25-26) to the Circuit Court of Appeals for the First Circuit, which affirmed the lower court. Thus it will be seen that the First Circuit Court of Appeals, as well as the district court (Rhode Island), has overturned the long established law that the burden of proving a patent invalid is on the defendant-infringer.

Even if the burden of proving a patent valid has now been put upon the patent owner the Circuit Court of Appeals should give the plaintiff an opportunity to sustain that burden since he had no prior notice of this change in the law and no opportunity to prepare his case with that law in mind.

The refusal of the lower court to act upon the method claims by making findings concerning them is a clear violation of the Rules of Civil Procedure promulgated by this Court which should not be ignored. The handling of this matter by the First Circuit Court in peremptorily holding claims 3 and 4 invalid irrespective of any finding of the lower court, is unjust. It shows how its arbitrary decision that method claim 2 was not proved to be valid by the patentee grew upon it, for it then thoughtlessly concluded that method claim 4, which includes an additional step in the process, is invalid for the same reasons as claim 2.

Prayer.

Wherefore, your petitioner respectfully prays that his petition be granted and for such other and further relief as may be proper.

PAUL J. BELLAVANCE,
By HAROLD E. COLE,
Attorney for Petitioner.

